

Attorney Docket No. IPCP:107US  
U.S. Patent Application No. 09/931,492  
Reply to Office Action of September 23, 2005  
Date: December 22, 2005

### **Remarks/Arguments**

#### **Claim Amendments**

Claims 11 and 33 have been amended to recite a publicly accessible database. This limitation is supported by the specification, for example, in paragraph [0012]. Therefore, no new matter has been added.

#### **The Rejection of Claims 11 and 33 Under 35 U.S.C. 112, Second Paragraph**

The Examiner rejected Claims 11 and 33 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner specifically cited the recitation of “wishing” in the two claims.

Although Applicants maintain that the phrase cited by the Examiner: “and said client is a party wishing to publish said product document” is not indefinite, in the interest of expediting examination, Applicants have amended, without prejudice, Claims 11 and 33 to remove the phrase. Applicants courteously request that the rejection be removed.

#### **The Rejection of Claims 2-11, 14-16, 19-22, 24-33, 36-38, and 41-44 Under 35 U.S.C. §103**

The Examiner rejected Claims 2-11, 14-16, 19-22, 24-33, 36-38, and 41-44 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,339,767 (Rivette et al.) in view of U.S. Patent No. 6,154,725 (Donner) in view of U.S. Patent No. 5,991,751 (Rivette et al.) and further in view of [further reference not named in the Office Action]. Applicants assume the Examiner intended to cite U.S. Patent No. 6,401,206 (Khan et al.) in the preceding incomplete sentence.

## **Claim 11**

### **Khan does not disclose a product document**

Claim 11 recites: “digitally notarizing said product document and obtaining a document notarization record, said document notarization record including a timestamp.” The Examiner has cited col. 4, lines 45-63 and the Abstract of Khan as teaching the above claim limitation.

The Abstract and col. 4, lines 45-63 teach using a personal public identity with respect to electronically signing a document. Khan does not teach, suggest, or motivate the document being a product document. In fact, signing a product document makes no sense. An electronic signature would only be applicable to a personal communication of some sort, for example, a letter, legal document, or memo. Khan reinforces the teaching of the document being a personal communication in Figures 6 and 7, which show a Notary-Public key. Clearly, a Notary Public would have no function with respect to a product document.

### **Khan does not digitally notarize a product document**

As noted above, Khan does not teach, suggest, or motivate a product document. Therefore, Khan cannot teach notarizing a product document.

### **Khan teaches against the invention recited in Claim 11**

Claim 11 recites a process whereby information regarding a product is introduced to the public by publishing a document including such information. Specifically, amended Claim 11 recites a publicly accessible database for this purpose. In stark contrast, Khan teaches: “This present invention is designed to enhance the exchange of *personal, confidential, legal and proprietary information* (emphasis added) reliably through electronic means.” (col. 1, lines 14-16). Khan is teaching the polar opposite of what Claim 11 recites. The product document of Claim 11 is placed in a publicly accessible database and is meant to be disseminated to and viewed by the public. Confidential and proprietary information by definition cannot and is not made public. In virtually all cases, personal information is meant to remain non-public and typically, legal information also is kept confidential. “A *prima facie* case of obviousness can be rebutted if one of the cited references teaches away from the claimed invention. See *In re Geisler*, 43 U.S.P.Q. 2d 1362, 1366 (Fed. Cir. 1997).”

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Rivette '767 does not teach the database and Web site of Claim 11

Claim 11 recites: "providing a searchable document database and a publication Web site in communication with a document database;" Applicants have presented arguments regarding this element of Claim 11 in the reply of August 27, 2004. For the sake of brevity, these arguments are referenced, but not repeated. However, it should be noted that Claim 11 has been amended to specifically recite a publicly accessible database, which differentiates the database recited in Claim 1 even further from Rivette '767.

Donner does not teach receiving a product document

Claim 11 recites: "electronically receiving a product document transmitted by a client's computer, where said product document provides information regarding a commercially available product;" Applicants have presented arguments regarding this element of Claim 11 in the reply of August 27, 2004. For the sake of brevity, these arguments are referenced, but not repeated.

Rivette '751 does not publish a document

Claim 11 recites: "publishing said product document by adding said product document to said document database, wherein said publishing is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product;" The Examiner has cited Figure 2 from Rivette regarding this element, without specifying or substantiating the relevancy of the figure with respect to the above claim element. Rivette teaches processing data and contains no teaching, suggestion, or motivation regarding publication.

Regarding Figure 2, Rivette states: "The present invention **processes patent information**." "More generally, the present invention processes any documents, some of which are related to patents, and others which are unrelated to patents. These documents are preferably of interest to a business entity, and include contracts, licenses, leases, notes, commercial papers, other legal and/or financial papers, etc., as well as patents." "The present invention also **processes other information**, preferably business-related information, including (but not limited to) research and development (R&D) information 206, financial information 216, patent

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licensing information 214, manufacturing information 208, and other relevant business information 210 (which may, for example, include human resources information).” “The present invention is adapted to **maintain and process** massive amounts of documents (several hundred thousand or more).” “For example, a user 212 (who may be a business analyst) may be assigned the job of evaluating the value of the corporation's patent portfolio (represented as part of the patent information 204). In order to fully analyze the value and applicability of the corporation's patent portfolio, the user 212 must take into account other information, such as R&D information 206, financial information 216, manufacturing information 208, and licensing information 214, for both the corporation and its competitors...For this and other purposes, the present invention includes functions for automatically **analyzing the patent information** 204 in conjunction with the financial information 216.” “The invention could also be used to **determine the value of a corporate entity's patent portfolio** for purposes of a merger or acquisition. The invention could also be used in a merger or acquisition context to determine a corporate entity's business direction. For example, if Company A is interested in acquiring Company B, Company A could use the invention to categorize all of Company B's patents into groups. The nature of these groups would be an indication of the types of work that Company B is involved in.” “The present invention is capable of **automatically processing** the patents in a group, or the patents in multiple groups (alternatively, the invention can automatically process a single patent).” “Accordingly, the invention supports and **facilitates "data drilling" and/or "data mining."** (emphasis added) (excerpts from col. 10, line 11 to col. 12, line 42).

Rivette only teaches processing and analyzing data.

**Rivette ‘751 and ‘767 teach against publication**

As shown above, Rivette ‘751 and ‘767 teach the processing of confidential and sensitive internal documents, such as: research and development information, financial information, patent licensing information, manufacturing information, and other relevant business information (which may, for example, include human resources information).” The present invention is a very public and accessible process. That is, the goal of the present invention is to make a product document “sufficiently accessible to one skilled in the relevant art who exercise

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reasonable diligence” within the meaning of 35 U.S.C. §102(b). Hence, the present invention places publications in the public domain for purposes of establishing bars to patentability.

On the other hand, the Rivette references disclose a system and method for internal use by a corporate entity as part of its decision-making process. This is the antithesis of a public and accessible process. Corporate viability and even survival require that business strategies and plans not be made accessible to competitors. Therefore, business entities go to great lengths to ensure the confidentiality and secrecy of meetings, documents, and data involved in decision-making/business plans. It is vitally important for businesses to keep such information private (not to publish such information) and in fact, there may be legal requirements to keep some of this information, such as human resource information, confidential. Thus, both Rivette references teach the opposite of the publication and public disclosure recited in Claim 11. “A *prima facie* case of obviousness can be rebutted if one of the cited references teaches away from the claimed invention. See *In re Geisler*, 43 U.S.P.Q. 2d 1362, 1366 (Fed. Cir. 1997).”

The references cited by the Examiner, considered individually and collectively, do not contain sufficient teaching, suggestion or motivation to combine/modify the references to create the present invention.

“Virtually all inventions are combinations of old elements. Therefore, an Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.” *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998).

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references and the teachings of the references can be combined only if there is some suggestion or incentive to do so. *In Re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002), citing *In re Fine*. Hence, elements of separate patents cannot be combined when there is no suggestion of such combination in those patents. *Panduit Corp. v. Dennison Manufacturing Co.*, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987).

In the present case, the prior art references cited by the Examiner do not contain an explicit or implicit teaching, suggestion, or motivation to create the subject invention and none

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teach, suggest, or motivate one to combine/modify their respective teachings with others to create the subject invention.

In the reply of August 27, 2004, Applicants addressed the Examiner's assertions that latency provides a motivation to combine Rivette '767 and Donner. For the sake of brevity, Applicants' arguments are not repeated here. However, Applicants respectfully submit that the Examiner has failed to provide sufficient substantiation for the statements regarding latency made in the first and second paragraph on page 3 of the Office Action.

The Examiner states that avoiding fraud is the motivation to combine Khan with Rivette '767. Again, the Examiner fails to sufficiently explain or substantiate the statement. The present invention is not concerned with fraud and electronic signatures as is Kahn. Digital notarizing is performed in the present invention to establish a time at which a document becomes of public record. In general, Kahn is addressing a completely different set of problems and concerns than the present invention or the other references cited by the Examiner. Kahn is teaching a public portable identity. Both Rivette patents state: "A system, method, and computer program product for *processing* (emphasis added) data are described herein." (first sentence of the Abstract). Donner teaches an intellectual property (IP) computer-implemented audit system for estimating the value of an IP folder (Abstract). Different than all the references cited by the Examiner, the present invention teaches publishing a product document to establish a bar to patentability.

Applicants also have shown that Kahn and both Rivette patents teach against the present invention.

For the reasons set forth above, Applicants respectfully submit that none of the references cited by the Examiner, considered individually and collectively, contain sufficient, teaching, suggestion, or motivation to combine or modify their teachings with those of others to create the invention claimed in Claim 11.

Rivette '767, Donner, Rivette '751, and Kahn fail to establish a *prima facie* case of obviousness with respect to Claim 11. Therefore, Claim 11 is patentable over Rivette '767, Donner, Rivette '751, and Kahn. Claims 2-10, 14-16, and 19-22, dependent from Claim 11, enjoy the same distinction from the cited references.

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### **Claim 33**

The Examiner stated that Claim 33 was in parallel to Claim 11 and rejected for the same reasons. Applicants have shown that Claim 11 is patentable over Rivette '767, Donner, Rivette '751, and Kahn. Therefore, Claim 33 also is patentable over Rivette '767, Donner, Rivette '751, and Kahn. Claims 24-32, 36-38, and 41-44, dependent from Claim 33, enjoy the same distinction regarding the cited references.

Applicants courteously request that the rejection be removed.

### **The Objection of Claims 12, 13, 17, 18, 23, 34-35, 39, and 40 as Being Dependent Upon a Rejected Base Claim**

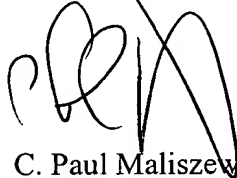
Claims 12, 13, 17, 18, 23, 34-35, 39, and 40 were objected to as being dependent upon a rejected base claim, but the Examiner indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 11 is allowable. Therefore, Claims 12, 13, 17, and 18, dependent from Claim 11, no longer depend upon a rejected base claim. Claim 33 is allowable. Therefore, Claims 34-35, 39, and 40, dependent from Claim 33, no longer depend upon a rejected base claim. Claim 23 was cancelled in the July 5, 2005 reply. Applicant request that the objection be withdrawn.

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**Conclusion**

Applicants respectfully submit that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Paul Maliszewski', is written over the text 'Respectfully submitted,'.

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